

## **REMARKS:**

Claims 82-93, 98-114, 118-120, 122, and 133-139 were pending in the application at the time of the Office Action. No claims are added or canceled herein. Claims 82-93, 98-114, 118-120, 122, and 133-139 are amended. Therefore, claims 82-93, 98-114, 118-120, 122, and 133-139 remain pending in this application.

### **Section 103 Rejections**

All pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Burke (US Patent No. 6,304,855), Kerret (International Publication No. WO 01/69364), Lee (US Patent Application Publication No. 2003/0096625), Kanefsky (US Patent No. 6,603,984), and the Examiner's taking of Official Notice. Applicant respectfully traverses the rejections below.

#### **Independent Claims 82, 133, 134, and 137**

In rejecting claim 82, the Examiner acknowledges that Burke fails to disclose the recited features "in response to receiving an incoming phone call, the wireless telephony device switching from the first operating mode to a second operating mode, wherein the second operating mode includes discontinuing the displaying of the first image and the second image." Office Action at 4. In rejecting claim 100, the Examiner acknowledges that Kerret fails to disclose the similar features "in response to receiving an incoming communication from a remote second sender that is different that the first sender; discontinue the displaying of the first image and the second image." Therefore it follows that Kerret also fails to teach or suggest the above-discussed features of claim 82.

The Examiner relies on the Lee reference as allegedly teaching these features recited in claim 82. *Id.* However, Lee is not prior art to the present application. The Lee reference was filed on August 8, 2002, and claims priority to two prior filed foreign (Korean) applications. Lee does not result from, or claim the benefit of, a prior-filed international (PCT) application, or of a prior US non-provisional or provisional application. Therefore, the earliest reference date for Lee (the effective date as a § 102(e) reference) is its U.S. filing date of August 8, 2002. *See*

MPEP 706.02(f)(1)(I)(B) (“The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international [PCT] application is its earliest effective U.S. filing date.”); MPEP 2136.03(I) (“the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date”).

As noted in the MPEP, “a U.S. national stage application shall be entitled to a right of priority based on a prior foreign application or international application” in cases where “priority was properly claimed in the international stage of the international application,” and “the file contains a copy of the certified copy of the priority document submitted to the International Bureau” in accordance with PCT Rule 17. *See* MPEP 1893.03(c)(I)-(II). The present application is a National Stage Entry of international application no. PCT/GB03/01340, filed March 26, 2003, which claims priority to GB application no. 0207373.2, filed March 28, 2002. *See* Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 mailed on April 13, 2005. Information available on the PAIR system shows that a certified copy of the GB application was received by the WIPO on June 4, 2003, and received by the USPTO for inclusion in the file wrapper of the present application on September 28, 2004. *See* “Certified Copy of Foreign Priority Application” PAIR entry dated 2004-09-28. Thus, the certified copy of the GB application was submitted in accordance with PCT Rule 17.1(a)-(b). *See* MPEP § 1893.03(c)(II). The specification and drawings that were filed in the international application and submitted in the present application in compliance with 35 U.S.C. § 371 are the same as the specification and drawings submitted on March 28, 2002 in the GB application. The Examiner has acknowledged that the present application has met the 35 U.S.C. § 119(a)-(d) conditions. *See* Bibliographic Data Sheet dated May 28, 2008. Thus, the present application is entitled to the benefit of the March 28, 2002 filing date of GB application no. 0207373.2. *See* 35 U.S.C. § 365(b); MPEP 1893.03(c). Accordingly, the Lee reference, which bears an earliest U.S. filing date of August 8, 2002, is **not prior art** as to claims of the present application. *See* MPEP § 706.02(b). Therefore, Lee cannot cure the above-discussed deficiencies of Burke and Kerret.

The Kanefsky reference also fails to cure the deficiencies of Burke and Kerret. Kanefsky is directed to “methods and systems for accessing various sources of information . . . using a wireless server and wireless device.” Kanefsky at col. 1, lines 45-47. As discussed in detail in Applicant’s Response to the Office Action dated July 20, 2009, Kanefsky fails to teach or suggest the features “in response to receiving an incoming phone call, the wireless telephony

device switching from the first operating mode to a second operating mode, wherein the second operating mode includes discontinuing the displaying of the first image and the second image.” See Applicant’s Response submitted on October 20, 2009 at 13. The Examiner does not contend otherwise.

For at least the reasons stated above, even assuming *arguendo* that the motivation to combine the cited references suggested by the Examiner is proper (which Applicant does not concede), the proposed combination does not teach or suggest all of the features of claim 82. Accordingly, the proposed combination does not establish a *prima facie* case of obviousness of claim 82 or the claims that depend therefrom. Similar remarks also apply to independent claims 133, 134, and 137, as well as the claims that depend therefrom, although these claims have different scope than claim 82. Thus, a *prima facie* case of obviousness has not been established with respect to those claims. Accordingly, Applicant respectfully requests reconsideration and removal of the present rejections.

#### Independent Claim 100

In rejecting claim 100, the Examiner relies on Lee as disclosing the recited features “wherein the system stores state information . . .” and “using the stored state information to display . . .” Office Action at 13. As discussed above, the Lee reference is not prior art as the present application, and therefore cannot provide a basis for the obviousness rejection. Applicant submits that the other cited references, taken alone or in combination, fail to teach or suggest the features “store state information usable to re-display the second image” and “subsequent to discontinuing the displaying of the second image, using the stored state information to re-display the second image” recited in amended claim 100. The Examiner does not contend otherwise.

Furthermore, as noted above, the Examiner acknowledges that Kerret fails to disclose the features “in response to receiving an incoming communication from a remote second sender that is different than the first sender; discontinue the displaying of the first image and the second image” recited in the previously pending version of claim 100. The Examiner also acknowledges that Burke fails to disclose the similar features “in response to receiving an incoming phone call, the wireless telephony device switching from the first operating mode to a

second operating mode, wherein the second operating mode includes discontinuing the displaying of the first image and the second image” recited in claim 82. Applicant submits that Kerret and Burke also fail to teach or suggest the similar features “subsequent to discontinuing the displaying of the second image, using the stored state information to re-display the second image” recited in amended claim 100.

In rejecting claim 100, the Examiner relies on a taking of Official Notice to cure the above-described deficiencies of Kerret and Burke. Specifically, the Examiner asserts as follows:

[D]iscontinuing a display associated with one mode (viewing advertisements) in order to conduct a transaction in a separate mode (receiving an incoming call) is well known to those of ordinary skill in the art, and official notice to that effect is hereby taken (*see for example US Application 2003/0096625*).

Office Action at 12 (emphasis added). Applicant respectfully traverses the Examiner’s attempted taking of Official Notice, and submits that such an attempted use of Official Notice to provide principal evidence upon which the rejection is based is improper. See MPEP 2144.03(A) (“It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.”). As noted in the MPEP’s discussion of Federal Circuit precedent, “[i]t would not be appropriate for the examiner to take official notice of facts without citing *a prior art reference* where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” *Id.* (emphasis added). Applicant notes that the Examiner cites the Lee reference as an example purportedly supporting this attempted taking of Official Notice. As discussed above, Lee is **not prior art** as to the present application.

Kanefsky fails to cure the above-discussed deficiencies of Kerret and Burke. For at least reasons similar those discussed above with respect to similar features recited in claim 82, Applicant submits that the Kanefsky reference fails to teach the features “subsequent to discontinuing the displaying of the second image, using the stored state information to re-display the second image” recited in amended claim 100. The Examiner does not contend otherwise.

For at least the reasons stated above, even assuming *arguendo* that the motivation to combine the cited references suggested by the Examiner is proper (which Applicant does not concede), the proposed combination does not teach or suggest all of the features of claim 100.

Accordingly, the proposed combination does not establish a *prima facie* case of obviousness of claim 100 or the claims that depend therefrom. Accordingly, Applicant respectfully requests reconsideration and removal of the instant rejections.

**CONCLUSION:**

Applicant respectfully submits the application is in condition for allowance, and an early notice to that effect is requested.

Applicant has petitioned herewith for what is believed to be the appropriate extension of time. If any further extensions are necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/6257-32202/EM.

Also filed herewith are the following items:

☒ Petition for Extension of Time

Respectfully submitted,

Date: October 4, 2010

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